



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/837,884 | 04/18/2001 | M. Russel Merchen | 124521-1000 | 8347 |

7590 12/01/2006

Gardere Wynne Sewell, LLP
3000 Thanksgiving Tower
1601 Elm Street Suite 3000
Dallas, TX 75201-4767

EXAMINER

DADA, BEEMNET W

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2135

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,884

Applicant(s)

MERCHEN ET AL.

Examiner

Beemnet W. Dada

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-15, 17-23, 25-31, 33-39, 41-47 and 49-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-15, 17-23, 25-31, 33-39, 41-47 and 49-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in reply to an amendment filed on September 11, 2006. Claims 1, 9, 25, 33 and 44 have been amended and claims 8, 16, 24, 32, 40 and 48 have been cancelled. Claims 1-7, 9-15, 17-23, 25-31, 33-39, 41-47 and 49-54 are pending.

Response to Arguments

2. Applicant's arguments filed September 11, 2006 have been fully considered but they are not persuasive. Applicant argued that Padgett (US 6,535,978 B1) fails to teach ensuring the integrity of data over some period of time or encrypting data after it is transmitted. Examiner disagrees.

3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Bisbee (US 5,615,268) teaches securely storing audit trail information about electronic data transfer, the digital certificate and at least a portion of the authentication response in a database, wherein the audit trail information includes the transaction information, and securely storing audit trail information includes ensuring the long-term data integrity and reliability of the audit trail information such that non-repudiation of the electronic data transfer may be established [see for example column 5, lines 16-41].

4. Applicant further argued that the timestamp associated with Bisbee (US 5,615,268) does not teach or suggest a timestamp associated with "when" the electronic document was created, it cannot be deduced whether an electronic document, though signed by an authorized person was not an original document. Examiner disagrees.

Art Unit: 2135

5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a timestamp associated with **when** the electronic document is **created**) are not recited in the claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Bisbee (US 5,615,268) teaches securely storing audit trail information about electronic data transfer, the digital certificate and at least a portion of the authentication response in a database, wherein the audit trail information includes the transaction information, and securely storing audit trail information includes ensuring the long-term data integrity and reliability of the audit trail information such that non-repudiation of the electronic data transfer may be established [see for example column 5, lines 16-41]; and wherein the audit trail information about the electronic data transfer includes an electronic document and a date/time stamp of the electronic document [see for example, column 5, lines 16-41]. Examiner asserts that the art on record teaches the claim limitations and therefore the rejection is respectfully maintained.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7, 9-15, 17-23, 25-31, 33-39, 41-47 and 49-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padgett et al. US Patent 6,535,978 B1 (hereinafter Padgett) in view of Bisbee et al. US 5,615,268 (hereinafter Bisbee).

8. As per claims 1, 9, 17, 25, 33 and 41 Padgett teaches a method for authorizing an electronic data transfer for healthcare transactions (see abstract) comprising the steps of:

receiving an authentication request containing a digital certificate and transaction information about the electronic data transfer from a requesting device via a communication link [column 7, lines 41-49 and column 8, lines 39-44];

determining whether the digital certificate is valid [column 7, lines 49-56 and column 8, lines 43-46];

creating an authentication response denying the authentication request when the digital certificate is not valid, or approving the authentication request when the digital certificate is valid [column 7, lines 49-62 and column 8, lines 43-46];

sending the authentication response to the requesting device via the communication link (i.e., approving or denying) [column 7, lines 49-62 and column 8, lines 43-46];

creating a digital receipt for the electronic data transfer when the digital certificate is valid [column 7, lines 49-62 and column 8, lines 43-49]; and

Padgett further teaches storing information about the transaction and the digital certificate so that non-repudiation of the transaction may be established [see for example column 8, lines 46-54].

Padgett is silent on securely storing audit trail information about the electronic data transfer, the digital certificate and at least a portion of the authentication response in a database, wherein the audit trail information includes the transaction information, and securely storing audit trail information includes ensuring the long-term data integrity and reliability of the audit trail information such that non-repudiation of the electronic data transfer may be established.

Bisbee teaches securely storing audit trail information about electronic data transfer, the digital certificate and at least a portion of the authentication response in a database, wherein the audit trail information includes the transaction information, and securely storing audit trail information includes ensuring the long-term data integrity and reliability of the audit trail information such that non-repudiation of the electronic data transfer may be established [see for example column 5, lines 16-41]; and wherein the audit trail information about the electronic data transfer includes an electronic document and a date/time stamp of the electronic document [see for example, column 5, lines 16-41]. It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to employ the teachings of Bisbee within the system of Padgett in order to further enhance the security of the system.

9. As per claims 2, 18 and 34, Padgett further teaches the method wherein the authentication request and the authentication response are transmitted via encrypted messages [column 7, lines 41-49].

10. As per claims 3, 19 and 35, Padgett further teaches sending a validation request for the digital certificate to a validation authority, and receiving a validation response from the validation authority indicating whether or not the digital certificate is valid [column 8, lines 1-5].

11. As per claims 4-7, 15, 20-23, 31, 36-39, 47 and 49-54 the combination of Padgett and Bisbee teaches the method as applied above. Furthermore, Bisbee teaches authentication information including, date/time stamp, digital receipt and the audit trail information about data transfer of an electronic document [see at least column 5, lines 16-41].

Art Unit: 2135

12. Claims 10, 26, and 42, recite similar limitations as described in claims 2, 18, and 34 as described above and are rejected under the same rationale.

13. Claims 11, 27, and 43, recite similar limitations as described in claims 3, 19, and 35 as described above and are rejected under the same rationale.

14. Claims 12, 28, and 44, recite similar limitations as described in claims 4, 20, and 36 as described above and are rejected under the same rationale.

15. Claims 13, 29, and 45, recite similar limitations as described in claims 6, 22, and 38 as described above and are rejected under the same rationale.

16. Claims 14, 30, and 46, recite similar limitations as described in claims 7, 23, and 39 as described above and are rejected under the same rationale.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

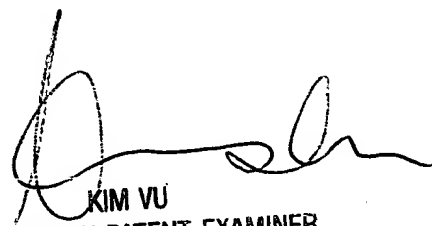
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beemnet W. Dada whose telephone number is (571) 272-3847. The examiner can normally be reached on Monday - Friday (9:00 am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Beemnet W Dada

November 25, 2006


KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100